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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WORKMAN NYDEGGER/MICROSOFT
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/264,432	GOLDMAN ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4,5,7,8,14,15,19,33-42,44,46,47 and 49-71* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4,5,7,8,14,15,19,33-42,44,46,47 and 49-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The OFFICIAL NOTICE stating that it is notoriously well known in the art to develop viewership profiles based upon "identifying closed captioning received from television programming" was not traversed and is accordingly taken as an admission of fact

2. Applicant's arguments, filed 28 January 2005, with respect to the rejection of claims 8 and 38 as being non-enabling have been fully considered and are persuasive. The rejection of claims 8 and 38 under 35 U.S.C. 112 have been withdrawn.

3. Applicant's arguments with respect to the rejection of independent claims 44, 49, 53, 54, and 58 as to usage of the Bedard reference have been fully considered but they are not persuasive.

With respect to applicant's arguments that the Bedard reference teaches away from a modification such that the profile comprises a single entry, the examiner respectfully disagrees. The Bedard reference explicitly teaches that the number of entries in the profile or array is limited and that the limit may be set to a percentage of available television channels or a set numerical limit (Col 4, Line 66 – Col 5, Line 6). It is the examiner's interpretation of Bedard that one having ordinary skill in the art would conclude, based upon the teaching of a set numerical limit or percentage, that it is not unreasonable that the number of entries in the profile could be as low as 1 or could be as large as the number of channels supported by the system (a set limit of zero entries would render the reference inoperative for its intended purpose). For example, if 10 channels are available, then it would reason that setting a 10% limit (as suggested in the reference) would result in a 1-entry profile and setting a 100% limit

would result in 10 entries. Furthermore, there is no objective evidence to conclude that when the profile is limited to a single entry as a result of the established limit that the system would not operate identically to that set forth in Figure 3 in the same manner as multiple entry profile when is no room for new entries within the profile (Col 5, Line 59 – Col 6, Line 1).

While not explicitly argued by applicant, it is noted that the common usage definition of the term "array" (accessible via http://dictionary.reference.com/search?q=array and reproduced in part for the applicant's review) is such that it may comprise a plurality of rows or a single row (entry). Accordingly, the particular usage of the term "array" in Bedard is not inconsistent with the examiner's interpretation that the reference suggests/encompasses the usage of a single entry profile or one-dimensional array (ex. 1 channel x N categories).

Array:

1. <programming> A collection of identically typed data items distinguished by their indices (or "subscripts"). The number of dimensions an array can have depends on the language but is usually unlimited.

An array is a kind of aggregate data type. A single ordinary variable (a "scalar") could be considered as a zero-dimensional array. A one-dimensional array is also known as a "vector".

(1995-01-25)

Source: *The Free On-line Dictionary of Computing, © 1993-2004 Denis Howe*

As to applicant's further arguments that the Bedard reference teaches away from the particular usage of a single entry, in light of the Bedard reference teaching that the method provides a means by which viewer preferences are weighted towards the most recently viewed entries (Col 6, Lines 2-4), such is not inconsistent with the single entry profile presented in the grounds of rejection. In particular, the usage of a single entry profile would still provide a higher weighting, namely 100%, towards the most recently viewed

programming and lower weighting, namely zero percent, for the programming that was not the most recently viewed since it would not be stored in the profile.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As aforementioned, it is the examiner's opinion that the particular reconstruction was proper in view of the teaching as to a numerical limit to the number of entries wherein the particular usage of a single entry as opposed to the exemplary disclosed number of entries would have been within the knowledge of ordinary skill at the time the claimed invention was made and would not have rendered the reference inoperative for its intended purpose of identifying information of interest from the Internet based upon monitored viewer behavior (Col 2, Lines 13-22).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4, 5, 7, 8, 14, 15, 19, 33-42, 44, 46, 49-51, 53, 63, 64, 66, 67, 69, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128) in view of Bedard (US Pat No. 5,801,747).

In consideration of claim 34 and 44, the Perlman et al. reference shows the schematic structure of a communications network for use with a "computer program product having one or more computer-readable media having computer-executable instructions" for implementing a "information retrieval system" such as the WebTV© client terminal [180] (Figure 1B). The client terminal [180] facilitates shared screen viewing of television/internet content. Subsequently, it handles both the "request for an information document from the server computer" [160] and "display" of "information documents" or HTML web pages (Page 5, Lines 9-19). The Perlman et al. reference teaches that the embodiment is operable to deliver potentially relevant material during off-peak hours and idle periods based upon a number of download criteria recognizable by those of ordinary skill in the art (Page 12, Lines 5-21). The "client system" [150] subsequently, "selects an advertisement from the advertisement repository" [220] and "inserts data representing the selected advertisement"

into the retrieved "information documents" which are "displayed . . . including the advertisement" [105] (Page 13, Lines 22-28).

The aforementioned Perlman et al. reference, however, does not explicitly disclose, nor preclude, the particular usage of criteria such as that associated with a client system compiled profile". The Bedard reference discloses a PC-TV that is operable to "compile a profile of the user of the information retrieval system . . . including information corresponding to television programming viewed by the user" (Col 4, Lines 15-26 and 49-65). The "profile" may be shared with broadcasters to target commercials or may be utilized in retrieving information of interest via the Internet (Col 8, Lines 16-21, 31-63). Furthermore, the reference teaches that the profile is preferably limited with respect to the number entries. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to "include information related to only a most recently viewed television program, such that the television programming viewed less recently than the most recently viewed television programming is not included in the profile for use in selecting the advertisements" for the purpose of minimizing the memory associated with the profile and advantageously providing a weighing viewer preferences that reflects only the most recently viewed program and current interests (Bedard: Col 6, Lines 2-4). Furthermore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Perlman et al. so as to utilize the profile generation of Bedard for the purpose of identifying and proving information of interest such as advertisements from the Internet using television viewing behavior as the download criteria (Bedard: Col 1, Line 67 – Col 2, Line 3).

In consideration of claim 49 and 53, Figure 1B of the Perlman et al. reference discloses the general architecture of an "information retrieval system" including a "remote server" [160/175] (Page 5, Line 27 – Page 6, Line 2), an "ISP" [160/175] (Page 8, Lines 24-25), and a "client" [180] such as a WebTV® terminal having a "display device" [105] that "has access to television programming viewed by the user" through shared screen viewing of television/internet content. The system, which utilizes "a computer program product having one or more computer-readable media having computer-executable instructions", is subsequently operable to insert an advertisement into a document displayed on the display device as previously set forth. In particular, the "remote server" [160/175] receives a request from the "client system" [180] for "an information document" upon which the "remote server" [160/175] "transmits the information document to the client system" (Page 5, Line 20 – Page 6, Line 18). The "client system" [180] subsequently, selects an advertisement from a local advertisement repository and "inserts data representing the selected advertisement" into the retrieved "information documents" (Page 13, Lines 22-28).

While the Perlman et al. reference discloses "accessing a profile of a user from the client system" in connection with "selecting an advertisement from an advertisement repository" for eventual "insertion into the information document based on the user profile" (Page 12, Lines 5-21), does not particularly disclose nor preclude the nature of the profile such that it contains "information related to only a most recently viewed television program". The Bedard reference discloses a PC-TV that is operable to "compile a profile of the user of the information retrieval system . . . including information corresponding to television programming viewed by the user" (Col 4, Lines 15-26 and 49-65). The "profile" may be

shared with broadcasters to target commercials or may be utilized in retrieving information of interest via the Internet (Col 8, Lines 16-21, 31-63). Furthermore, the reference teaches that the profile is preferably limited with respect to the number entries. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to "include information related to only a most recently viewed television program, such that the television programming viewed less recently than the most recently viewed television programming is not included in the profile for use in selecting the advertisements" for the purpose of minimizing the memory associated with the profile and advantageously providing a weighing viewer preferences that reflects only the most recently viewed program and current interests (Bedard: Col 6, Lines 2-4). Furthermore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Perlman et al. so as to utilize the profile generation of Bedard for the purpose of identifying and proving information of interest such as advertisements from the Internet using television viewing behavior as the download criteria (Bedard: Col 1, Line 67 – Col 2, Line 3).

Claims 4 and 35 are rejected wherein the "act of inserting data representing the selected advertisement is conducted at the client system" (Perlman et al.: Page 18, Lines 11-20).

Claims 5 and 36 are rejected wherein the Perlman et al. reference teaches that information such as advertisements may be "pre-downloaded" and stored in memory on the client system (Perlman et al.: Page 12, Lines 15-26; Page 18, Lines 11-20; Figure 5).

Claims 7 and 37 are rejected wherein the "information document" is a web page in HTML format (Perlman et al.: Page 7, Lines 29 – Page 8, Line 7).

Claims 8 and 38 are rejected wherein the Perlman et al. reference discloses that "act of compiling the profile includes an act of including in the profile user information further characterizing the user" such as information gathered from tracking web sites that the user may have visited (Perlman et al.: Page 12, Lines 5-14) in addition to the aforementioned "television programming viewed by the viewer" of Bedard.

In reference to claims 14-15 and 39-40, the Perlman et al. reference discloses that the host server may provide supplemental information including "news" [308] and "reference information related to the content of the television programming" such as sports information provided on ESPN® (Page 11, Lines 24-31 – Page 12, Lines 1-2).

Claims 19 and 41 are met wherein the Perlman et al. reference discloses that information may be "pushed" to the client during off-peak periods (Figure 5; Page 12, Lines 18-21; Page 20, Lines 14-30). It is well known in the art that "push" technology does not require "direct user assistance".

In consideration of claims 33 and 42, the combined references do not explicitly disclose nor preclude that the compiling of a "profile includes an act of identifying closed captioning received from television programming". Applicant's admission of fact provides evidence that it is notoriously well known in the art to develop viewership profiles based upon "identifying closed captioning received from television programming". Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to "identify closed captioning received from television programming" so as to provide a means for particularly classifying the characteristics (ex. category/sub-category) of viewed programming.

Claim 47 is rejected wherein the "selected advertisement is selected prior to requesting the information document" since Perlman et al. teaches that the advertisements are selected, downloaded, and locally cached prior to a user requesting a particular web page.

Claim 50 is rejected wherein "communications between the remote server and the client system pass through an ISP" since the ISP facilitates the delivery of the information document stored on cache of the remote server.

Claim 51 is rejected wherein as aforementioned the "client system" [180] "displays the information document, including the selected advertisement" on the "display device of the client system" [105] (Perlman et al.: Page 18, Lines 11-20).

Claims 63 and 64 are rejected wherein the "user profile" of Bedard is "updated each time the client views a television program" for a meaningful duration since it only comprises one entry.

Claims 66 and 67 are rejected wherein the "user profile" of Bedard is "categorized according to topics of television programming" (Figure 2; Col 4, Lines 49-65).

Claims 69 and 70 are rejected wherein "information relating to the user profile is only retained in the user profile for only a set period of time" corresponding to the user watching a new program for a meaningful period.

7. Claims 46 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128), in view of Bedard (US Pat No. 5,801,747), and in further view of Brown et al. (US Pat No. 5,887,133).

In consideration of claims 46 and 52, the Perlman et al. reference suggests that the "inserted data" or advertisements may be overlay any web page, however, it is unclear if it

necessarily replaces a "preexisting advertisement that was included within the information document requested form the server" (Page 18, Lines 11-20).

The Brown et al. reference discloses a client device [56] capable of displaying television programming and "requesting . . . an information document form the server computer". The client device selects an advertisement from an advertisement repository [24/26/28] for "replacing a preexisting advertisement included with the information document requested from the server" based upon the user profile [216] (Figures 2, 7-9; Col 8, Line 7 – Col 10, Line 33). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to utilize the teachings of Brown et al. so as to particularly select, insert, and display a requested information document comprising a targeted advertisement as claimed for the purpose of providing a means to deliver information of interest from the Internet through the replacement of undesirable advertisement content with other information of interest such as advertisement content based upon the users profile.

8. Claims 54-58, 60-62, 65, 68, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US Pat No. 5,887,153) in view of Bedard (US Pat No. 5,801,747).

In consideration of claims 54 and 58, Figure 3 of the Brown et al. reference discloses an "information retrieval system" [200] including a "remote server" [14/16/22], an "ISP" [202], and a "client system" [214] having a "display device" [212] that is capable of displaying television programming (Col 3, Lines 63-65; Col 10, Lines 14-18). Accordingly, the "ISP" [202] "receives a request from the client system for an information document" from the "remote server" [14/16/22], "obtains the information document form the remote server",

"accesses a profile of a user from the client system", "selects an advertisement from an advertisement repository" [34] "based on the user profile" [216] (advertisements may be considered information of interest, health-related information or warnings in the case of public service announcements as is understood in the art), "inserts data representing the selected advertisement into the information document" and "transmits the information document to the client system" (Brown et al.: Figures 2, 7-9; Col 8, Line 7 – Col 10, Line 33).

The Brown et al. reference, suggests that it may contain past activity data (Col 10, Lines 19-24), however does not particularly disclose that the "profile includes information related to only a most recently viewed television program" as particularly claimed. The Bedard reference discloses a PC-TV that is operable to "compile a profile of the user of the information retrieval system . . . including information corresponding to television programming viewed by the user" (Col 4, Lines 15-26 and 49-65). The "profile" may be shared with broadcasters to target commercials or may be utilized in retrieving information of interest via the Internet (Col 8, Lines 16-21, 31-63). Furthermore, the reference teaches that the profile is preferably limited with respect to the number entries. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to "include information related to only a most recently viewed television program, such that the television programming viewed less recently than the most recently viewed television programming is not included in the profile for use in selecting the advertisements" for the purpose of minimizing the memory associated with the profile and advantageously providing a weighing viewer preferences that reflects only the most recently viewed program

and current interests (Bedard: Col 6, Lines 2-4). Furthermore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Brown et al. so as to utilize the profile generation of Bedard for the purpose of identifying and proving information of interest such as advertisements from the Internet using television viewing behavior as the download criteria (Bedard: Col 1, Line 67 – Col 2, Line 3).

Claim 55 is rejected wherein the "ISP" implicitly "accesses and stores the profile prior to receiving the request for the information document". For example, it is unclear as to how the system would operate to swap an advertisement using a user profile if it has not already accessed and stored that profile for which the swap is based.

Claim 56 is rejected wherein the "client system displays the information document including the selected advertisement on the display device of the client system" (Brown et al.: Figures 8-9).

Claim 57 is rejected wherein the "selected advertisement replaces a preexisting advertisement included with the information document" (Brown et al.: Figures 2, 7-9; Col 8, Line 7 – Col 10, Line 33).

In consideration of claims 60-62, the combined references do not explicitly disclose nor preclude the particular timing associated with the updating of the remote user profile. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to remotely update the singular record profile information routinely so as to advantageously ensure that the user is being provided with advertisements that reflect the user's most current interests in light of the combined teachings. Accordingly, it would have been obvious for the "ISP to receive" an updated profile "each time the client requests an

information document" or "each time the client begins a new Internet session that is serviced by the ISP" in connection with establishing a session for the retrieving an information document or on a "daily basis" associated with the aforementioned establishment of sessions by the user for a plurality of given days for which the Internet is accessed for the purpose of ensuring that user in conjunction with establishing a session with the ISP (necessary to facilitate the delivery of the requested information document) is provided with advertisements alongside the requested information documents that are reflective of the user's interests including those associated most recently viewed programming.

Claim 65 is rejected wherein the "user profile" of Bedard is "updated each time the client views a television program" for a meaningful duration given that it only comprises one entry.

Claim 68 is rejected wherein the "user profile" of Bedard is "categorized according to topics of television programming" (Figure 2; Col 4, Lines 49-65).

Claim 71 is rejected wherein "information relating to the user profile is only retained in the user profile for only a set period of time" corresponding to the user watching a new program for a meaningful period.

9. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US Pat No. 5,887,153) in view of Bedard (US Pat No. 5,801,747) and in further view of Gupta et al. (US Pat No. 6,487,538).

In consideration of claim 59, the combined references do not explicitly disclose nor preclude that the "advertisement is selected by the ISP, based on the user profile, prior to receiving the request for the information document". The Gupta et al. reference discloses that it is known and advantageous for ISPs to "select [advertisements] . . . based on the user

profile, prior to receiving [a] request for [an] information document" (Col 6, Lines 10-46). Accordingly, it would have been obvious to one having ordinary skill in the art to modify the combined references such that the ISP [202] pre-selects and caches advertisements from the remote repository [34] based upon the user profile [216] for the purpose of decreasing the latency associated with the retrieval of targeted advertisements from a remote repository for eventual insertion into information documents.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
March 24, 2005

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600